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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/754,536	01/12/2004	Simon Robert Walmsley	PEA25US	9210

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SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, 2041  
AUSTRALIA

EXAMINER
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PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

MAIL DATE	DELIVERY MODE
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07/03/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/754,536	<b>Applicant(s)</b> WALMSLEY, SIMON ROBERT	
	<b>Examiner</b> PRAMILA PARTHASARATHY	<b>Art Unit</b> 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 2 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3 and 5-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/27/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the communication 05/22/2008. Claims 1, 3, 5 – 17 are currently pending.

#### ***Information Disclosure Statement***

2. An initialed and dated copy of Applicant's IDS form 1449 is attached to the Office action.

#### ***Terminal Disclaimer***

3. The terminal disclaimer filed on 5/22/2008 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of copending application 10/727158 has been reviewed.

#### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia #2002953135 on 12/02/2002 and 2002953134 on 12/2/2002. It is noted, however, that applicant has not filed a certified copy of the above mentioned applications as required by 35 U.S.C. 119(b).

#### ***Response to Arguments***

5. Applicant's arguments filed on 5/22/2008 have been fully considered but they are not persuasive. With respect to 35 USC 112, First paragraph rejection, Applicant states that "paragraphs [4628]-[4787]" fully enables the amended independent claims 1 and 5, and dependent claims 3 and 6-17. Examiner has carefully reconsidered Applicant's cited part of the disclosure, however, respectfully disagrees that these suggested part of the disclosure (or any other part of the disclosure) provides any structural or functional support for the claimed limitations.

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Cited paragraphs disclose:

[4628] System calls ChipF's GetProgramKey function, passing in the result

[4628]-[4636] Updating P's key;

[4637]-[4714] Multiple key single memory vector

[[4715]-[4785] ChipU verifies the received signature

[4786]-[4887] "non-authenticated" writes

Thus, no where in the disclosure Examiner can find any support for "loading an intermediate program", "intermediate program being customized for a particular one or more of a plurality of potential integrated circuit", or "enables loading or running of unverified code". Examiner, therefore, maintains the previous rejection.

With respect to prior art rejection, Applicant argues that, "Sormunen et al (US publication 2003/0014663) does not disclose the subject matter of amended independent claims 1 and 5 and dependent claims 3 and 6-17". Additionally, Applicant argues that "the loaded intermediate program enables the running of unverified code on the integrated circuit. Examiner respectfully disagrees. Applicant correctly agrees with the Examiner that, "PG1-PG3" are verified before being run (paragraph [0034]-[0037]), however omits and/or ignores the disclosed "examines the unverified part of the program code ... and it is possible to boot other program PG1-PG3, after which the electronic device 1 can be used normally" (See paragraph [0034]-[0041]). Examiner maintains prior art rejection.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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Examiner suggests to amending the claims to overcome prior art rejection with the disclosed subject matter from the instant specification, without adding new matter. The rejection appearing below has the same rationale as previous office action, as the Applicant has not amended the independent claims substantially to overcome the prior art rejection.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 – 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims limitations recited in 1 – 17 do not have any support in the specification other than the summary of the invention wherein, the summary contains exact claim language, i.e., summary of the invention is a copy of all the claim limitations.

Claims 1 – 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims limitations recited in 1 – 17 do not have any functional or descriptive support in the specification.

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Applicant is requested to exactly point out wherein the specification any support can be found for the limitations that are recited in Claims 1 – 17, in response to this office action.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 3, 5 – 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Sormunen et al. (US Publication 2003/0014663).

As per Claim 1, Sormunen teaches “loading an intermediate program onto the integrated circuit, the intermediate program being customised for a particular one or more of a plurality of potential integrated circuits that, when run on the processor, enables loading or running of unverified code on only the particular one or more integrated circuits” (paragraph [0032 – 0041]). Sormunen discloses, “When the booting is continued ... programs PG1, PG2, PG3, boot program are checked ... the computed digital signature is compared with the digital signature stored in memory (thus, verified programs are loaded and run)” and “the unverified program code are run and the electronic device can be used normally”. Sormunen further discloses that the aim of the invention is to provide a method for securing an electronic device so that the boot-up step is verified as well as unauthorized and unverified program code is controlled or prevented from being loaded or run by the electronic device.

As per Claim 5, Sormunen teaches, “run a boot program that prevents unverified software from subsequently being loaded onto, or run by, the integrated circuit”; and

run an intermediate program customised for a particular one or more of a plurality of potential integrated circuits that, when run on the integrated circuit, enables loading or running

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of unverified code on only that particular one or more integrated circuits (paragraph [0032 – 0034]). Sormunen discloses, "When the booting is continued ... programs PG1, PG2, PG3, boot program are checked ... the computed digital signature is compared with the digital signature stored in memory (thus, verified programs are loaded and run)" and "the unverified program code are run and the electronic device can be used normally". Sormunen further discloses that the aim of the invention is to provide a method for securing an electronic device so that the boot-up step is verified as well as unauthorized and unverified program code is controlled or prevented from being loaded or run by the electronic device.

As per Claim 3, Sormunen teaches "wherein the intermediate program enables the loading or running of the code only when the code includes data indicative of the particular one or more integrated circuits" (paragraph [0040 – 0041]).

As per Claims 6 and 12, Sormunen teaches "receive software data and a digital signature of the software data generate a first digest from the software data; and compare the first digest against a second digest obtained via the digital signature that accompanied the received software data; wherein the program is considered valid when the first and second digests match" (paragraph [0032 – 0036]).

As per Claim 7, Sormunen teaches "wherein one or both of the digests were generated using a SHA1 function" (paragraph [0047]).

As per Claims 8 and 14, Sormunen teaches, "wherein the boot program contains a plurality of keys, and one of the keys is selected for use in generating the first digest, the key being selected in accordance with a selection criterion" (paragraph [0044 – 0047]).

As per Claim 13, Sormunen teaches, "wherein the encryption function is RSA" (paragraph [0045 – 0047]).

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As per Claim 9 and 15, Sormunen teaches “the selection criterion is time-based, a particular one of the keys being selected depending on the time the selection is made” (paragraph [0044 – 0047]).

As per Claims 10 and 16, Sormunen teaches, “wherein the selection criteria relates to a physical arrangement or configuration of the integrated circuit” (paragraph [0044 – 0047]).

As per Claims 11 and 17, Sormunen teaches “wherein the physical arrangement or configuration includes one or more of the following: one or more pads wired to a reference voltage or to ground; one or more fuses, one or more of which has been blown; or the contents of non-volatile memory” (paragraph [0032 – 0034]).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRAMILA PARTHASARATHY whose telephone number is (571)272-3866. The examiner can normally be reached on 8:00a.m. to 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pramila Parthasarathy/  
Primary Examiner, Art Unit 2136  
July 1, 2008